



## ATTACHMENT A

### Remarks

Turning first to the rejections of the claims (the “Response to Arguments” will be considered below), claims 10-22 and 28-45 have been rejected under 35 U.S.C. 103(a) as being “unpatentable over” the previously cited Williams et al (“Williams”) and Morrison et al (“Morrison”) patents. These rejections are respectfully traversed. However, it is noted that some amendments have been made to some of the independent claims to improve the form thereof and other amendments have been made to some of the dependent claims.

Independent claim 10 recites, *inter alia*, a “computer - readable medium containing computer instructions and data for carrying out the operations of:...selecting one of said medium input signals for presentation.” It is respectfully submitted that this language patentable distinguishes over the Williams patent. In the latter, the user performs the selection while the remote control merely communicates the user selection. In contrast, in claim 10, the claim “selecting” operation is performed by a method embodied on a computer – readable medium.

Further, claim 10 recites “transmitting said modified media signals to said presentation device.” It is respectfully submitted that this feature is not disclosed in the Williams patent wherein the media input signal is modified after it is transmitted to the presentation device. In this regard, the Williams patent provides that “input signals, (e.g., channel–select and changes, volume changes...) are input to system 100 via system controller 104, which in turn forwards control signals to the appropriate components to perform the desired function” (emphasis added) (see column 7, lines 65-67 and column 8, lines 1-2).

Although the Office Action does not comment on the first distinction discussed above, the Office Action acknowledges that the Williams reference “only discloses sending control signals to manually adjust the television and fails

to specifically disclose that the modified signal is transmitted to the presentation device.”

The Examiner relies on the Morrison patent as rendering this distinction obvious. In particular, it is stated in the Office Action that “Morrison discloses a television receiver that receives an RF input and external video and audio input (see elements 100 and VIDEO IN and AUDIO IN (Figure 3)), which transmits the video signal to a switch, which transmits either RF or external video output to a presentation device 158 in Figure 3” (emphasis in the original). It is also noted in the Office Action that Morrison discloses “a database similar to the Williams database 700 in Figure 2, and that this database dictates what settings will be adjusted by circuits 155 and 135 in Figure 3, and later transmitted to the presentation device” (emphasis in the original).

It is respectfully submitted that it would not be obvious to combine the teachings of the Williams and Morrison patents so as to arrive at the present invention. The Morrison patent relates to an autopilot feature which “operates television systems as shown in Figure 3 having electronic program guides (EPGs)” (see column 2, lines 48-50). The database in Figure 2 shows “different setting for various types of programming” (see column 3, lines 18-20). Thus, as explained in column 3 of the reference, the autopilot system will set audio and video settings based on the character of the program in the EPG database so that the settings will be different for a hockey game as compared with a comic movie. These setting are determined by scanning the EPG database and matching topic and theme with the preset list stored in memory.

It is respectfully submitted that these teachings of Morrison have nothing to do with the teachings of the Williams patent which relate to a method and apparatus for automatically determining and dynamically updating user preferences in an entertainment system. In this regard, the Morrison reference clearly has nothing to do with “associating each of a plurality of setting values for

a presentation device with each of a plurality of media input signals in a multimedia system,” as claimed in claim 9.

The Examiner argues in the Response to Arguments that Williams is relied on as teaching this limitation and that “one cannot show non-obviousness by attacking references individually where the rejections are based on combinations of references.” It is respectfully submitted that this argument and the other arguments made in the Response to Arguments are not well taken.

First, contrary to the contentions in the Office Action, Applicant is not attacking the references individually but is rather pointing out what the references teach individually and why, based on teachings, the combination proposed is not obvious. In contrast, it is respectfully submitted that, in making the rejections here, the Examiner is borrowing piecemeal from the references without regard to the context of the teachings thereof. Specifically, in this section of the Office Action, it is argued that Morrison discloses “a switch for transmitting a select one of a plurality of media signals” (emphasis in the original). Although this issue is dealt in more detail below in connection with claim 28, it is pointed out that the issue here is not only whether Morrison teaches this particular feature but also whether it would be obvious to combine Williams and Morrison based on the actual teachings of the Morrison patent. In this regard, even assuming *arguendo* that Morrison teaches the subject matter, quoted above this does not mean that the combination is obvious. The Morrison system is strictly concerned with changing settings based on program content as determined by scanning an EPG and it is not seen that this has anything to do with the present invention nor the method and apparatus of the Williams reference.

As indicated above, the Examiner argues that “Morrison discloses a database similar to Williams database 700 in Figure 2.” However, the teachings on which the Examiner relies relating to switch 137 do not concern the database of Figure 2 so that any similarity between the Morrison database and database 700 of Williams is irrelevant. As pointed out above, video switch 137 receives

closed captioned data at a first input and a VIDEO IN signal at the second input and selects the proper source of closed captioned data under the controller 110. This has nothing to do with the database of Figure 2 as was pointed out previously, and it is respectfully submitted that this teaching of the Morrison patent with respect to matching closed caption data to a video signal has nothing to do with the method and apparatus of the Williams patent. Further, given the actual teaching of the Morrison patent in question here, there would be no reason to incorporate this teaching in the Williams patent.

It is noted that in the Response to Arguments, the Examiner contends that “Applicant also argues that the switch limitation recited in claim 10 ‘has nothing to do with the database of Figure 2 of the reference’” and then points out that claim 10 “does not recite a switch limitation, let alone a switch limitation relating to any type of database, therefore this argument is moot.” It is respectfully submitted that this response misstates the argument presented by Applicant.

As pointed out above, the Examiner cites and appears to somehow rely on the teaching of Figure 2 and the “similarity” between a database 700 of Williams. In the quoted passage, Applicant is simply pointing out that the database of Figure 2 has nothing to do with the switch 137 of Figure 3 on which the Examiner relies so that whatever the similarity between Figure 2 of Morrison and the database 700 of Williams, this is irrelevant to the basic rejection which relies on switch 137 of Figure 3. The fact that claim 10 does not recite a switch is also irrelevant and, in this regard, Applicant never contended that that “switch limitation” recited in claim 10 “has nothing to do with the database of Figure 2 of the reference.”

The core argument here concerns the issue of whether it would be obvious to combine the Williams and Morrison patents and, as set forth above, it is respectfully submitted that it would not, given the actual teachings of the Morrison patent on which the Examiner is relies. Again, the Examiner contends that claim 1 is obvious because of (1) the teaching of the Morrison patent with

respect to “a switch which transmits either RF or external video output to a presentation device” and (2) the similarity between the database of Figure 2 and the Williams database 700. As stated above, Applicant has merely pointed out that the latter “similarity” has nothing to do with the switch 137 and the teachings of the Morrison patent with respect to the switch, i.e., the teaching of a switch for controlling associating closed caption data with a video signal, is not relevant to the present invention nor to the Williams system.

Turning to independent claims 14, this claim is similar to claim 10 and distinguishes over the cited references for basically the same reasons discussed above.

Independent claim 28 recites “a switch for transmitting a selected one of a plurality of media signals to said output device in response to said selection commands.” Independent claim 40 includes a similar recitation and the Examiner has referred to the rejection of claim 40 in rejecting claim 28. In rejecting claim 40, the Examiner contends that the Morrison patent “discloses a switch coupled to the media devices and presentation devices for transmitting a selected one of the media signals to the presentation device in response to the selection command (see element 137 in Figure 3 and column 4, line 4-8 for video switch 137 selection of the proper video input).”

As discussed above, it is respectfully submitted that switch 137 of Morrison is not coupled to a plurality of media devices and a presentation device for transmitting a selected one of the media signals to the presentation device but rather performs an entirely different function as part of the closed – captioned circuitry of the television receiver of the Morrison reference. In rejecting claim 40, the Examiner concludes that “[a]t the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the bus, as taught by Williams using the video switch, as taught by Morrison, for the purposes of eliminating possible conflicts and bandwidth congestion which may occur over a bus architecture by using the switch, which routes one signal at a time.” It is

respectfully submitted that this conclusion in no way follows from the actual teachings of the Morrison reference which, as discussed above relates to an entirely different problem, and is certainly not concerned with eliminating possible conflicts and bandwidth congestion which may occur over a bus architecture. Thus, it is respectfully submitted that claims 28 and 40 also patentably distinguish over the cited references.

As noted above, in the Response to Argument, the Examiner has contended that claim 28 is broad in reciting a “switch for transmitting a select one of a plurality of media signals.” The Examiner further contends that the term “media signals” is “broad” and could refer to video, audio or any data transmitting within the signal (such as closed caption data).” The Examiner concludes the “since Morrison’s switch 137 teaches accepting video signals from two sources and delivering the proper closed captioned data from each signal to the output device, therefore, the switch disclosed by Morrison meets the limitation of a switch that processes ‘media signals’.”

It is respectfully submitted that there are at least two problems with this argument. The first was discussed above, viz, even assuming that the teachings of the Morrison patent can be read as disclosing what the Examiner states, this does not mean that it would be obvious to combine the Williams and Morrison patents. Again, it is respectfully submitted that it is only with the impermissible use of hindsight that one would attempt to modify the teachings of the Williams patent based on the disclosure of Morrison with respect to matching closed caption data to the appropriate video signals.

Further, even if the Morrison patent disclosed the subject matter that the Examiner has quoted, it is not proper examination to simply lift this feature into the Williams patent without some basis for doing so. In this regard, it is respectfully submitted that one cannot simply argue that because one reference teaches A, B and C and another reference teaches D, the combination of A, B,

C, D is obvious because by combining the two references, the resultant hybrid combination will be A, B, C, D.

Finally, the argument made by the Examiner here is based on the assumption that the term “media signals” is “broad”; however, claim 28 is concerned with media signals from a plurality of different media devices and claim 28 has been clarified in this regard. In contrast, the “media signals” in Morrison are, as noted above, “closed captioned data” and a “VIDEO IN” signal. It is respectfully submitted that these signals are not media signals from a plurality of different media devices, and the contention that “the switch 137 disclosed by Morrison meets the limitation of a switch that processes ‘media signals’,” both (1) begs the question since this is not what is being claimed and (2) does not address the issue of why, given the actual teachings of the Morrison patent taken in context, the proposed combination would be obvious.

With respect to independent claims 41 and 42, these claims include recitations similar to those of claims 28 and 40 and are patentable for basically the same reasons.

The dependent claims are, of course, patentable for at least the reasons set forth above in support of the patentability of the claims parent thereto.

Allowance of the application in its present form is respectfully solicited.

**END REMARKS**